

DETAILED ACTION

Acknowledgments

1. Applicants' amendment filed on August 22, 2011 is acknowledged. Accordingly claims 79-82 and 85-97 remain pending and have been examined.

Response to Arguments

2. Applicant's arguments filed August 22, 2011 have been fully considered but they are not persuasive.
3. With respect to claims 79,89 and 90, Applicant argues that neither Walker nor Messner make any mention of "...storing, by at least one computer, image data designated by at least one of said plurality of subscriber retailers in at least one database, said image data being based upon terms and conditions specific to said at least one subscriber retailer...; "...accessing, by said at least one computer, said image data to determine an appearance of said prepaid voucher for said selected subscriber retailer...."; or "...generating, by said at least one computer, an image including said image data in response to receiving the order..." That Scroggie does not cure the deficiencies of Walker and Messner.

In response, Examiner respectfully disagrees and submits that Scroggie does disclose the claimed limitations as shown in the rejection below. According to Scroggie the image background and pattern are pre-stored in the retailer website. Upon the customer's order, the customer is allowed to supply information including name of recipient, coupon selection and supermarket selection. The customer supplied

informations are merged with the system provided information such as coupon expiration date, logo, the product image, ... terms of the offer e.t.c., to generate the coupon that is delivered to the customer or recipient. This is also in accord with the Applicant specification which requires the customer to supply the name of the recipient before the prepaid voucher is generated. Accordingly Scroggie does disclose the claimed "...storing, by at least one computer, image data designated by at least one of said plurality of subscriber retailers in at least one database, said image data being based upon terms and conditions specific to said at least one subscriber retailer...; "...accessing, by said at least one computer, said image data to determine an appearance of said prepaid voucher for said selected subscriber retailer...."; or "...generating, by said at least one computer, an image including said image data in response to receiving the order..."

4. Applicant further argues that while Scroggie discloses input information that is incorporated into each coupon, the input information is provided by the consumer, and not designated a subscriber retailer.

In response, Examiner respectfully disagrees and submits that the input information provided by the consumer is merged or incorporated with the information obtained by the system as discussed in the preceding paragraph. Accordingly the information is provided by the designated subscriber retailer. This is also in line with the Applicant's specification which requires the consumer to supply the "name of the recipient".

5. Applicant further argues that Scroggie make no mention of the "...image data being based upon terms and conditions specific to said at least one subscriber retailer..."

In response Examiner respectfully disagrees and submits that Scroggie does make mention of the terms and conditions specific to said at least one subscriber retailer..." because fig. 11 describes among others "terms for receiving savings amount", "legal text"; "expiration date"; "supermarket designation" etc. Accordingly Scroggie does disclose the claimed limitation and the rejection should be sustained.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 79-82, and 85-96**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al U.S. Patent No. 6,138,106 in view of Messner U.S. Patent No. 6,370,514 B1 and further in view of Scroggie et al (hereinafter "Scroggie") U.S. Patent No. 6,014,634.

8. As per claims 79, 89 and 90, Walker et al discloses a payment method comprising:

offering a prepaid voucher for a plurality of subscriber retailers to a customer, said prepaid voucher exchangeable by said customer for value from at least one of said subscriber retailers;

storing, by at least one computer, image data designated by at least one of said plurality of subscriber retailers in at least one database, said image data being based upon terms and conditions specific to said at least one subscriber retailer;

receiving, by said at least one computer, an order from said customer for said prepaid voucher (see fig. 7A, *which discloses receive request to purchase gift code and amount of money to be credited to gift code record step 126*);

said order specifying a selected one of said plurality of subscriber retailer and including a payment from said customer (see fig. 7B, *which discloses transmit credit card number and amount of money to be credited to transaction processing network/credit card processor for gift code authorization*);

accessing, by said at least one computer, said image data to determine an appearance of said prepaid voucher for said selected subscriber retailer;

generating, by said at least one computer, an image including said image data in response to receiving the order;

issuing, by said at least one computer, said prepaid voucher in response to receiving said order and said payment from said customer (see fig. 7A, *which discloses generate gift code step 128; store requested value in gift code record step 130*),

said pre-paid voucher including voucher information identifying the selected subscriber retailer

generating, by said at least one computer, a token associated with said prepaid voucher (see fig. 7A, *which discloses generate gift code step 128; generate and transmit ID code to buyer step 122*);

associating, by said at least one computer, said token with said prepaid voucher in said at least one database (see fig. 7B, *which discloses flag gift certificate record as prepaid and store authorization code step 144*);

receiving, by said at least one computer, a request from one of said plurality of subscriber retailers for validation of said issued prepaid voucher in response to presentment of said issued prepaid voucher from said customer to said one of said plurality of subscriber retailers, said request including said token (col. 8, lines 40-55, *which discloses the process starting (step 162) with central controller 12 receiving a gift certificate code (step 163) via a transmission from a redeemer operating the buyer/redeemer interface 16 via the Internet*);

comparing, by said at least one computer, said token in said request against said token associated with prepaid voucher in said at least one database (col. 11, lines 30-45, *which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*); and

validating said prepaid voucher in response to a positive result of said comparison (col. 11, lines 30-45, *which discloses If the status field 80 indicates that the record has been filled, i.e. that the gift certificate code has been redeemed, the record is left unchanged, and the next record is examined (steps 216, 220). If the status indicates the record is pending, i.e. that the gift certificate code has not been redeemed*).

9. What Walker does not explicitly teach is

offering prepaid vouchers for a plurality of subscriber retailers to a customer, said prepaid vouchers exchangeable by said customer for value from at least one of said subscriber retailers;

storing, by at least one computer, image data designated by at least one of said plurality of subscriber retailers in at least one database, said image data being based upon terms and conditions specific to said at least one subscriber retailer;

accessing, by said at least one computer, said image data to determine an appearance of said prepaid voucher for said selected subscriber retailer;

generating, by said at least one computer, an image including said image data in response to receiving the order;

said order specifying a selected one of said plurality of subscriber retailer and including a payment from said customer;

said pre-paid voucher including voucher information identifying the selected subscriber retailer

10. Messner discloses the method comprising:

offering prepaid voucher for a plurality of subscriber retailers to a customer, said prepaid voucher exchangeable by said customer for value from at least one of said subscriber retailers (*see fig. 3, which discloses plurality of subscriber retailers; col. 2, lines 1-5, which discloses that it is an object of the present invention to provide a centralized system based on a voucher server, which system can handle marketing and redemption of vouchers for a number of participating third party merchants/virtual malls. This centralized processing frees participating merchants from having to develop the in-house technical expertise necessary to administer such a system*);

11. Scroggle discloses the method comprising:

storing, by at least one computer, image data designated by at least one of said plurality of subscriber retailers in at least one database, said image data being based upon terms and conditions specific to said at least one subscriber retailer (*see fig. 11, which discloses the template for the voucher image describing terms and conditions of the voucher; see col. 10, line 60-col. 11, line 45, which discloses that "Several intricate background patterns are stored in advance for use in this step of the coupon creation process. The background pattern for current use is selected from the pre-stored patterns on a regular or random basis*);

accessing, by said at least one computer, said image data to determine an appearance of said prepaid voucher for said selected subscriber retailer (*see fig. 11, which discloses the template for the voucher image describing terms and conditions of the voucher; see col. 10, line 60-col. 11, line 45, which discloses that "Several intricate background patterns are stored in advance for use in this step of the coupon creation process. The background pattern for current use is selected from the pre-stored patterns on a regular or random basis*);

generating, by said at least one computer, an image including said image data in response to receiving the order (*see fig. 11, which discloses the template for the voucher image that is dynamically generated; see col. 10, line 60-col. 11, line 45, which discloses that "FIG. 11 shows a typical coupon format and FIG. 12 summarizes the functions performed in creating the coupon dynamically*);

said order specifying a selected one of a plurality of subscriber retailer and including a payment from said customer (*see fig. 11, which discloses*

redeemable only at Ralphs; see col. 1, line 45-col. 2, line 5, which discloses For security reasons, the transmitted incentive may be encoded with the identity of the retailer selected by the customer, and preferably also contains a customer identification code);

said pre-paid voucher including voucher information identifying the selected subscriber retailer (*see fig. 11, which discloses redeemable only at Ralphs; see col. 1, line 45-col. 2, line 5, which discloses that :for security reasons, the transmitted incentive may be encoded with the identity of the retailer selected by the customer, and preferably also contains a customer identification code);*

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a payment method comprising offering prepaid vouchers for a plurality of subscriber retailers to a customer, said prepaid vouchers exchangeable by said customer for value from at least one of said subscriber retailers; said order specifying a selected one of a plurality of subscriber retailer; said pre-paid voucher including voucher information identifying the selected subscriber retailer in view of the teachings of Messner and Scroggle in order to ensure adequate security and free participating merchants from having to develop the in-house technical expertise necessary to administer such a system

12. As per **claim 80**, Walker failed to explicitly disclose the payment method, further comprising:

communicating said validation of said prepaid voucher to said one of said plurality of subscriber retailers in response to said request and said positive result of said comparison.

Messner discloses the payment method, further comprising:

communicating said validation of said prepaid voucher to said one of said plurality of subscriber retailers in response to said request and said positive result of said comparison (see fig. 2).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a payment method comprising communicating said validation of said prepaid voucher to said one of said plurality of subscriber retailers in response to said request and said positive result of said comparison in view of the teachings of Messner in order to free participating merchants from having to develop the in-house technical expertise necessary to administer such a system

13. As per **claim 81**, Walker failed to explicitly disclose the method, further comprising:

receiving, by at least one computer, a notification of use of said prepaid voucher from said one of said plurality of subscriber retailers in response to communicating said validation; and

indicating a redemption of said prepaid voucher in said database in response to receiving said notification of use.

Messner discloses the method, further comprising:

receiving a notification of use of said prepaid voucher from said one of said plurality of subscriber retailers in response to communicating said validation (see fig. 2A); and

indicating a redemption of said prepaid voucher in said database in response to receiving said notification of use (see fig. 2A).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a payment method comprising receiving a notification of use of said prepaid voucher from said one of said plurality of subscriber retailers in response to communicating said validation; and indicating a redemption of said prepaid voucher in said database in response to receiving said notification of use in view of the teachings of Messner in order to ensure adequate security and free participating merchants from having to develop the in-house technical expertise necessary to administer such a system

14. As per claim 82, Walker further discloses the method, further comprising:

said order being received from said customer via a computer network (col. 8, lines 40-55).

15. As per claims 85 and 95, Walker failed to explicitly disclose the method, wherein issuing said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber.

Scroggle discloses the method, wherein said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber (see fig. 11, which discloses redeemable only at Ralphs)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method comprising said generating said prepaid voucher includes providing fields of an image of a retail gift voucher including voucher information identifying said selected subscriber in view of the teachings of Scroggle in order to ensure security

16. As per claim 86, Walker further discloses the method, further comprising:
delivering said prepaid voucher to a recipient via postal service (col. 8, lines 10-25).

17. As per claim 87, Walker further discloses the method, further comprising:
delivering said prepaid voucher to said recipient via electronic mail (fig. 7A).

18. As per claim 88, Walker failed to explicitly disclose the method, wherein said token comprises a randomly generated token.

Scroggle discloses disclose the method, wherein said token comprises a randomly generated token (col. 11, lines 10-45).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a method wherein said token comprises a randomly generated token in view of the teachings of Scroggle in order to ensure security

19. As per claim 91, Walker further discloses the system, further comprising:
said redemption system configured to cause said prepaid voucher in response to said request (col. 11, lines 30-45).
20. As per claim 92, Walker further discloses the system, further comprising:
said request descriptive of a partial use of said prepaid voucher (see fig. 5); and
said redemption system configured to indicate said partial use of said voucher in response to said request (see fig. 5).
21. As per claim 93, Walker further discloses the system, further comprising:
a payment system in communication with said network, said payment system configured to approve said payment (see fig. 7A-C).
22. As per claim 94, Walker failed to explicitly disclose the system, further comprising:

said website configured to cause generation of a voucher image associated with said prepaid voucher in accordance with said voucher image data.

Scroggle discloses the system, further comprising:

said website configured to cause generation of a voucher image associated with said prepaid voucher in accordance with said voucher image data (see fig. 11; see abstract; col. 2, lines 55-65)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system comprising said at least one database including voucher image data for said prepaid voucher; and said website configured to cause generation of a voucher image associated with said prepaid voucher in accordance with said voucher image data in view of the teachings of Scroggle in order to ensure adequate security

23. As per **claim 95**, Walker failed to explicitly disclose the system, further comprising:

said voucher image is associated with each of said plurality of subscribing retailers.

Scroggle discloses the system, further comprising:

said voucher image is associated with each of said plurality of subscribing retailers (see fig. 11; col. 10, lines 25-60; col. 11, lines 10-45).

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the method of Walker et al and incorporate a system

comprising said voucher image is associated with each of said plurality of subscribing retailers in view of the teachings of Scroggle in order to ensure security

24. As per claim 96, Walker further discloses the system, further comprising:
said website configured to receive a beneficiary designation for said prepaid voucher from said customer and to cause delivery of said prepaid voucher to said beneficiary (see fig. 6, which shows names of beneficiaries).

25. As per claim 97, Walker failed to explicitly disclose the system further comprising: said voucher image data relating to said order, said customer and said token

Scroggie discloses the system further comprising: said voucher image data relating to said order, said customer and said token (col. 10, line 60-col. 11, line 45)

Accordingly it would have been obvious to one of ordinary skill in the art at time of applicant's invention to modify the system of Walker et al and incorporate a system further comprising said voucher image data relating to said order, said customer and said token in view of the teachings of Scroggie in order to ensure security by ensuring that the correct background/pattern is used in generating the voucher

Conclusion

26. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO

Art Unit: 3685

Customer Service Representative or access to the automated information system, call
800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/
Primary Examiner, Art Unit 3685
October 25, 2011